

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Lowell L. Winger et al.

Serial No.: 10/785,273

Title: METHOD AND/OR APPARATUS FOR DETERMINING A SECOND PICTURE FOR TEMPORAL DIRECT-MODE BLOCK PREDICTION

Filed: February 24, 2004

Attorney Docket No.: 03-1431 / 1496.00341

Examiner: Anyikire, C.

Art Unit: 2482

In Response To: Advisory Action mailed November 3, 2010

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal by an attorney either of record or acting under 37 CFR 1.34.

REMARKS

Review is requested as claimed limitations are not met by the proposed combination of the Jeon and Kondo references.

The Examiner erred in the current Office Action (issued November 3, 2010) by ignoring evidence presented by Applicants' representative showing that the proposed combination does not teach or suggest the given reference picture of claims 1, 10 and 19. The rejection asserts that a given reference picture of a co-located intra mode block in Jeon can be determined in a second list (see page 3 of the Office Action issued November 3, 2010). However, the assertion is not supported by any evidence or explanation, it merely points to columns and lines in Jeon. In contrast, Applicants' representative presented evidence which shows that the co-located intra mode block of Jeon is **not** associated with any reference pictures (see pages 9-10 of the Amendment filed on July 9, 2010). The Examiner does not offer any explanation or evidence why the showing by Applicants' representative is allegedly incorrect. Instead, the Examiner incorrectly asserts that Applicants' arguments "are moot in view of the new ground(s) of rejection" (see page 2 of the Office Action issued November 3, 2010). This assertion in itself is another error because the grounds of rejection in the current Office Action remain unchanged from grounds of rejection in the previous Office Action (issued April 13, 2010). Applicants' representative showed that the co-located intra mode block of Jeon does not reference another picture. In reply, the Examiner merely repeats the earlier rejections without any attempt to explain why Applicants' representative is allegedly wrong. Simply repeating an old

rejection argument does not make that argument valid. Improperly brushing off the evidence from Applicants' representative as "moot" does overcome the evidence. The Examiner has erred by ignoring the evidence on record and so the rejections should be overturned.

The Examiner further erred by maintaining the same rejection arguments against claim 1 steps (A) and (D) as used in an earlier Office Action (issued August 25, 2009) despite those arguments being overturned by the 2009 Pre-Appeal Board. In an earlier Request for Pre-Appeal Brief Review (filed December 15, 2009), Applicants' representative argued that Jeon did not disclose or suggest claim 1 steps (A) and (D) when the claim was considered as a whole. Prosecution was reopened per a Notice of Panel Decision from the Pre-Appeal Brief Review (issued March 15, 2010). The issue was decided in favor of the Applicants. The earlier Office Action rejected the claimed step (A) based on paragraph 0088 lines 1-2 of Jeon and the claimed step (D) based on paragraph 0111 of Jeon (see page 3 of the August 2009 Office Action). The Amendment filed after prosecution was reopened narrowed both steps (see page 2 of the July 2010 Amendment). Now the current Office Action still rejects the claimed steps based on the same material in Jeon (see page 3 of the November 2010 Office Action), despite the narrowing amendment. This issue was already decided when the claimed steps were broad. The same decision should be reached now that the claimed steps are narrower. As such, the rejection should be overturned again for the same reasons that it was overturned in 2009.

Applicants' representative believes that the Examiner has erred by omitting one or more elements needed for a *prima facie*

rejection. For example, the limitations of (A) finding in a first list a co-located picture and a block and (B) determining in a second list a given reference picture of the block are not met by the proposed combination of references when the claim is considered as a whole. Furthermore, the Examiner has erred by still using the same arguments previously overturned by the 2009 Pre-Appeal Board.

If the current Pre-Appeal Board members find some way to interpret the claims and/or references in a way different than characterized above, Applicants' representative requests that the Board reopen prosecution. Applicants' representative also requests that the Examiner initiate a telephone interview (586-498-0670) in an effort to consider whether a modification to the claims is possible in order to be interpreted as discussed.

The Examiner is respectfully invited to call the Applicants' representative should it be deemed beneficial to further advance prosecution of the application.

Respectfully submitted,
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Dated: January 31, 2011

c/o Pete Scott
LSI Corporation
Docket No.: 1496.00341 / 03-1431
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